

REMARKS

Claims 1-12 are pending and stand rejected under 35 U.S.C. § 102(b) over Tochio, U.S. Patent No. 6,563,613. By this Amendment, Applicant respectfully traverses these rejections. Reconsideration is respectfully requested.

Nowhere does Tochio show or suggest, as required by independent claims 1 and 5 of the present invention, an optical subscriber system that “judges whether the transmission line distance is larger or smaller than a reference value.” The Office Action states (see pages 2-3) that Tochio shows that “the station 11b decides and gives notice of the transmission timing of the uplink main signal of each subscriber unit. As a result, the uplink main signals from the subscriber units will no longer collide.” (Column 7, lines 1-5.) However, this teaching of Tochio does not show or suggest comparing the measured transmission line distances to a reference value as required by claim 1. Attempting to find the missing limitation of a “reference value”, the Office Action states that “it is necessary and inherent that a reference value must be given to compare, judge, and give notice of the transmission timing.” Applicant respectfully disagrees.

The Examiner bears the burden of showing inherency. M.P.E.P. § 2112. As M.P.E.P. § 2112 provides (emphasis in original), “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Tochio simply states that it “decides and gives notice” of the transmission timing. Tochio is absolutely silent in regard to how it “decides” the transmission timing. Applicant respectfully submits that it is not necessary

and inherent that Tochio uses a reference value in its decision. For example, as Tochio is trying to avoid collisions between messages from subscriber stations, Tochio could base its decision on a comparison between transmission times among the various subscriber stations, and not in comparison to a reference value. Applicant therefore submits the use of a reference value as claimed is not inherent or necessary in the system of Tochio.

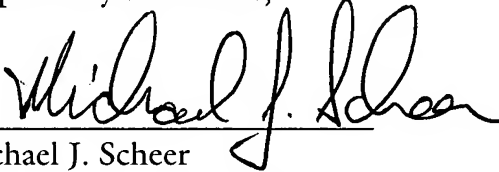
The Examiner bears the burden of showing that a “reference value”, required by independent claims 1 and 5 of the present application, is inherent. However, the Office Action has not provided any basis in fact or technical reasoning that a reference value is inherent. M.P.E.P. § 2112. Applicant has shown a scenario where Tochio could make its decision without considering a reference. As a result, withdrawal of the rejections of independent claims 1 and 5, and the dependent claims thereon, is respectfully requested.

In addition, Applicant thanks the Examiner for considering and initialing the Form 1449 submitted April 22, 2003. Applicant also respectfully requests that the Examiner consider and initial the Form 1449 submitted April 1, 2002, a copy of which is provided for the Examiner’s convenience.

Applicant has shown that pending claims 1-12 are patentable under 35 U.S.C. § 102 over the cited art. In view of the above, each of the pending claims is currently in condition for allowance and such action is earnestly solicited.

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Respectfully submitted,

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